

2/27/01

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 11
HWR

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Trustees of Dartmouth College

v.

Jonathan D. Heavey

Opposition No. 113,404
to application Serial No. 75/375,714
filed on October 20, 1997

William R. Hansen of Nims, Howes, Collison, Hansen & Lackert
for Trustees of Dartmouth College.

Michelle H. MacKenzie of Landels, Ripley & Diamond
for Jonathan D. Heavey.

Before Quinn, Wendel and Drost, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Jonathan D. Heavey filed an application to register the
mark DARTMOUTH MOOSE and design, as shown below, for
"clothing, namely, T-shirts, athletic jerseys, sweat shirts,
sweat pants, shorts, pants, hats."¹

¹ Serial No. 75/375,714, filed October 20, 1997, based on an
allegation of a bona fide intention to use the mark in commerce.

The Trustees of Dartmouth College filed an opposition to registration of the mark on the ground of likelihood of confusion under Section 2(d) of the Trademark Act. Opposer alleges that since December 17, 1769 and long prior to applicant's filing date, opposer has used the names and marks DARTMOUTH and DARTMOUTH COLLEGE in connection with the offering of its educational services; that since before 1900 opposer has used the names and marks DARTMOUTH and DARTMOUTH COLLEGE on the uniforms worn by its sports teams and the Roman letter "D" has also been closely associated with these teams, appearing on caps, jerseys and the like; that since long prior to the filing date of the involved application, with the consent of opposer and through related companies, wearing apparel has been offered for sale using either alone or in combination DARTMOUTH and the Roman letter "D"; and that applicant's mark DARTMOUTH MOOSE and design is a colorable imitation of opposer's famous names and marks, the

use of which mark, as applied to applicant's goods, would be likely to cause confusion.

Applicant, in his answer, denied the salient allegations of the notice of opposition, although admitting that opposer had used the names Dartmouth and Dartmouth College in connection with educational services.²

The Record

The record consists of the file of the involved application; the trial testimony depositions, with accompanying exhibits of Richard G. Jaeger, Director of Athletics for opposer and Karen J. Mongeon, Licensing Officer for opposer; and the status and title copies of six registrations of opposer³ and applicant's responses to

² Applicant further pleaded the affirmative defenses of unclean hands, estoppel, acquiescence, waiver and the geographic descriptiveness of the names Dartmouth and Dartmouth College. Applicant has failed to pursue any of these affirmative defenses, however, and thus no consideration has been given thereto.

³ Registration No. 987,129, issued June 25, 1974, for the mark DARTMOUTH for "educational services - namely, offering college and graduate level courses; first renewal;

Registration No. 1,727,764, issued October 27, 1992, for the mark DARTMOUTH AUTHENTICS for "athletic jerseys, sweat shirts, sweat pants, shorts, T-shirts, knit shirts, pants, hats, headbands"; Section 8 accepted;

Registration No. 1,729,497, issued November 3, 1992, for the mark DARTMOUTH AUTHENTICS and design for the same wearing apparel as above; Section 8 accepted;

Registration No. 2,041,854, issued March 4, 1997, for the mark 1900 TUCK AT DARTMOUTH and design for "clothing, namely, T-shirts and sweatshirts;

Registration No. 2,158,256, issued May 19, 1998, for the mark DARTMOUTH WINTER CARNIVAL for "T-shirts, sweatshirts and sweaters"; and

Registration No. 2,305,032, issued January 4, 2000, for the mark COL.DARTMOUTH/NOV.HANT:IN AMERICA 1769 and design for "clothing, namely, shirts, T-shirts, sweat shirts, sweat pants,

opposer's interrogatories made of record by means of
opposer's notice of reliance. Applicant took no testimony
and made no evidence of record. Only opposer filed a brief.

Dartmouth College, as represented by its trustees, was
established as an educational institution in 1769. Opposer
has used both the name DARTMOUTH and the Roman letter "D" on
its athletic uniforms since the 1880's. The official letter
"D" is considered the symbol of all the athletic teams and
is awarded to all those who earn varsity status. (Jaeger
deposition, p.8). Although the teams do not presently have
an official mascot, a moose has been used as an unofficial
mascot for the past five or six years and a moose figure has
appeared at sporting events.

Opposer began its licensing programs in the 1970's,
permitting several top manufacturers to produce wearing
apparel and other items bearing Dartmouth marks, including
DARTMOUTH and the letter "D", to be sold by various
retailers. The apparel includes T-shirts, athletic jerseys,
sweat shirts, sweat pants, shorts, pants and hats. Most
goods display one mark, but certain items, such as hats, may
bear both the letter "D" and the name Dartmouth College.
Potential purchasers for the licensed goods include
students, alumni, the teams, the faculty, and fans in
general at the athletic events. Sales of this merchandise

pants, shorts, boxer shorts and socks, jackets, sweaters, hats

runs around \$1 million per year, resulting in a royalty intake for opposer of approximately \$100,000 per year. (Mongeon deposition, p. 13).

Applicant is a Dartmouth graduate who had occasional employment in the physical education department and attended meetings involving attempts by the students and staff to find a new mascot for the college's teams. (Jaeger deposition, p. 14). Applicant helped conduct a survey in the mid-1990's in which the students chose a moose to be the unofficial mascot. (Applicant's response to Interrogatory No. 2).

The Opposition

Priority is not an issue here in view of opposer's submission in its notice of reliance, as well as the identification during the testimony of Karen Mongeon, of status and title copies of the six noted registrations for the mark DARTMOUTH and variations thereof.⁴ See King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Furthermore, opposer has established prior and continuous use of both DARTMOUTH and the Roman letter "D" since as early as the 1880's, a date well prior

belts, pajamas, night shirts and ties."

⁴ Although opposer failed to plead ownership of these registrations in its notice of opposition, opposer timely introduced the registrations during its testimony period and applicant made no challenge thereto. Accordingly, the registrations are considered part of the record.

to the earliest date available to applicant, namely, the filing date of his application.

Thus, we turn to the issue of likelihood of confusion, making our determination on the basis of those of the *du Pont*⁵ factors which are relevant in view of the evidence of record. Two key considerations in any analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods with which the marks are being used. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Looking first to the respective marks, we agree with opposer that the term DARTMOUTH is the dominant element in both opposer's DARTMOUTH marks and applicant's DARTMOUTH MOOSE mark. While marks must be considered in their entirety in determining likelihood of confusion, it is well established that there is nothing improper in giving more or less weight to a particular portion of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Here the word DARTMOUTH clearly dominates all the marks. Applicant's addition of the Roman letter "D", a designation in which opposer has established long prior

⁵ *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

common law rights, only reinforces the similarity of connotation and commercial impression of the word DARTMOUTH. While we are not convinced that opposer has established common law rights in the use of a moose per se, although opposer so argues, we consider this additional element to have only a small impact in applicant's mark as a whole. While potential purchasers may well make an association between the term MOOSE (and the moose design) with opposer, even without this recognition of the mascot reference, we find the commercial impressions created by the respective marks highly similar. The source indicating significance of the word DARTMOUTH remains the same.

Thus, on the basis of this high degree of similarity of overall commercial impression, we turn to the respective goods. We find the clothing items upon which applicant intends to use his mark to be identical to items upon which opposer is presently using its DARTMOUTH marks. Furthermore, since there are no limitations in the identification of goods in the application as to any particular channels of trade, we must assume that applicant's goods would travel in all the normal channels of trade and be sold to all the usual purchasers for goods of this nature. See *Canadian Imperial Bank v. Wells Fargo Bank*. 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Clearly the potential purchasers for clothing items bearing a DARTMOUTH MOOSE mark would encompass those also purchasing opposer's DARTMOUTH items. We must assume that applicant's wearing apparel, whether sold on the Internet, by mail-order catalog or in retail stores, would be available in the same type of outlets as opposer's wearing apparel.

While opposer has also raised the factor of the degree of fame of its DARTMOUTH marks, we do not find that opposer has proffered sufficient evidence to establish, for purposes of this proceeding and these goods, that DARTMOUTH has attained the status of a famous mark. We would readily concur, however, that the evidence is adequate to establish that opposer's DARTMOUTH mark is well-known, not only in connection with the educational institution and its sports teams, but also in connection with the college-related clothing items upon which the marks are used. This in itself weighs strongly in opposer's favor in determining likelihood of confusion.

Inasmuch as applicant has made no evidence of record, we have no reason to consider the use of the mark DARTMOUTH by third parties. Applicant's response in his interrogatories with respect to the existence of other marks containing the term DARTMOUTH goes unsubstantiated. (See applicant's response to Interrogatory No. 15). Instead we make our determination on the basis that opposer's DARTMOUTH

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marks are well-known in the relevant field and entitled to a broad scope of protection.

While opposer has also raised the issue of applicant's intent in adopting his mark, in view of his prior association with Dartmouth College and his knowledge with respect to the student body's choice of a moose as a mascot for the athletic teams, we find the evidence insufficient to go so far as to hold that applicant has acted in bad faith. Furthermore, such a finding is not necessary here. The remaining *du Pont* factors which are before us weigh overwhelming in opposer's favor on the issue of likelihood of confusion.

Decision: The opposition is sustained and registration is refused to applicant.